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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,866	05/29/2001	Brian Sorrentino	1340-1-021CIP2	4688

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EXAMINER

LI, QIAN JANICE

ART UNIT PAPER NUMBER

1632

DATE MAILED: 12/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/866,866

Applicant(s)

SORRENTINO ET AL.

Examiner

Q. Janice Li

Art Unit

1632

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 20 November 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☒ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 16, 17, 21-28.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

ANNE M. WEHBE, PH.D.
PRIMARY EXAMINER



Continuation of 5. does NOT place the application in condition for allowance because:

Claims 16, 17, 21, 22, 25, and 26 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Ross et al* (US 6,313,277, IDS/AA), in view of *Niman et al* (US 5,563,247).

In the response to the final Office action, applicants argue, in addition to reiterating the previous arguments, that at the time of filing of this application, there was no method known in the art to produce an isolated antibody that recognized an extracellular portion of an ABC transporter in a living cell.

In response, as indicated in the first action on merit, it is *Niman et al* who teach the method of making antibody against a cell receptor polypeptides. They disclose a monoclonal antibody that binds to a ligand containing only 10-30 amino acid residues (e.g. claim 1), which is a very small extracellular portion of a receptor protein in a living cell, therefore, it is the combined teaching of Ross and Niman that would arrive at the claimed invention.

Applicants then argue that the unsigned Declaration indicate that the antibody generation technique proposed by the Examiner is not predictable, and would provide no reasonable expectation of success.

In response, the Declaration has not been considered, not only because it is defective (unsigned) but also because it is drawn to issues not newly raised in the final Office action.

With respect to the arguments regarding the natural conformation of an antigen, the issue has been addressed in pages 4 & 5 of the final Office action, and discussed during the interview, thus, will not be reiterated here.

Claims 16, 17, and 21-28 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Ross et al* (US 6,313,277, IDS/AA) and *Niman et al* (US 5,563,247), as applied to claims 16, 17, 21, 22, 25, and 26 above and further in view of *Godfrey et al* (US 6,528,623).

Applicants presented similar arguments as to the combined teachings of Ross and Niman, which have been addressed above, and will not be reiterated.